

REMARKS/ARGUMENTS

Applicant responds herein to the Office Action dated August 1, 2005.

By the present amendment, the applicant has amended claim 25 and retained its dependent claims 26-28. The remaining claims have been canceled without prejudice. Therefore, it is only necessary to focus on the patentability question as it relates to independent claim 25.

In the Office Action, it is contended that claim 25 is either anticipated or, in the alternative, rendered obvious by JP 63-15710. The Office Action is also asserting that claim 25 is rendered obvious by Konuma (6,127,279), in view of Sanada (5,843,527), in further view of Carter (6,221,168). Reconsideration is requested in view of the amendments to claim 25 herein and the following remarks.

In the “**Response to Arguments**” (beginning at page 5 of the Office Action), the Examiner contends that the applicant’s claimed controller does not represent structure, because it does not specifically state that it has “internal hardware/software that causes the operation of UV emitter...”. In effect, the Examiner is insisting on the applicant recite in the claim the internal hardware and the software module that causes the controller to have that particular structural features. This impermissibly imposes a burden on the applicant to include limitations from the specification into the claims, which is contrary to the law.

Respectfully, it suffices that the applicant states that the invention -- which is an apparatus -- has a controller that is structured to perform the function. The applicant is entitled to describe structure in terms of the function that it performs. That is a matter of basic patent law.

The law on this point has not changed for at least half a decade. Thus, in *Ex Parte Pilkington*, 137 USPQ 229, 230 (POBA, 1962), the Board of Appeals of the Patent Office stated:

“we likewise do not believe that the expressions ‘without hinderance from said walls’... ‘to permit said layer of molten glass to flow laterally unhindered to the limit of its free flow under the influence of gravity and surface tension’ appearing in the claims constitute process limitation or statements of how the apparatus works and are without structural significance. They function as limitations upon the chamber wall spacing and the temperature regulators to which they refer, and in our opinion constitute with the latter a proper structural definition of the apparatus.” (emphasis added).

So too here, the recitation in claim 25 of what the controller causes to happen constitutes defying the structural limitations of the claim. It is not necessary to recite in the claim that the function is performed by a particular piece of software or to define in great detail the structural components that perform the function. To force applicant to do so would be to force the applicant to impermissibly import limitations from the specification into the claims, which the applicant is not required to do.

With the foregoing introduction, it is abundantly clear that in the present invention, the structural features of the controller are such that it controls the other claimed components to supply ozone water to the substrate surface while rotating the substrate, and to emit ultraviolet light during removal of the photoresist film. This produces radicals in the ozone water, to improve the photoresist film removing capability greatly.

JP 63-15710 and Konuma disclose or suggest nothing relating to such a controller that has the structural features that enable it to control the components to produce the radicals as noted above. The Examiner may not infer or assume such features in the disclosure when the plain text of these references does not disclose or suggest it. Therefore, these references cannot be deemed to provide any motivation, nor a disclosure of the present invention, and these references should not be relied upon to deny the patentability of the claims in the present invention.

In view of the foregoing remarks, it is respectfully submitted that claim 25 and its dependent claims are clearly patentable over the prior art of record.

Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 1, 2005

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November 1, 2005

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